

REMARKS / DISCUSSION OF ISSUES

Claims 1-17 are presently pending. Claims 1 and 8 are independent.

Unless indicated to the contrary, claims are amended to eliminate European-style phraseology and present the claims for U.S. prosecution.

Applicants request that the Examiner states whether the drawings are accepted.

Rejections under 35 U.S.C. § 103

Claims 1-17 are rejected as being obvious by Bryant (U.S. 1,148,376). For at least the reasons set forth herein, Applicants respectfully submit that all claims are patentable over the applied art.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

In addition, under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid or unpatentable under § 103. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727; 82 U.S.P.Q.2D 1385 (2007), citing, in part *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

However, the Court in *KSR* continued: "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (CA6 1964)))." Moreover, if there is no suggestion to combine the teachings of the applied art, other than the use of Applicants' invention as a template for its own reconstruction, a rejection for obviousness is improper. *Ex parte Crawford, et al.* Appeal 20062429, May 30, 2007.

In the Response under Rule 111, Applicants provided arguments in support of the patentability of all pending claims. As the nexus of the present rejection remains substantially the same as the non-final rejection prompting the Rule 111 Response, Applicants reiterate as germane their position in support of patentability.

i. Claim 1

Claim 1 is drawn to a personal care apparatus and features:

"... *an air pump having a suction piece and a motor for exerting a suction effect on the human skin...*"

Applicants note that the applied art includes a mouthpiece 11 and not a motor as claimed. Therefore, the applied art fails to disclose each and every element of claim 1. As such, claim 1 is patentable over the applied art. Moreover, claims 2-7, which depend from claim 1, are patentable for at least the same reasons.

The Office Action concedes that the reference to *Bryant* fails to disclose a motor, and turns to *In re Venner* (CCPA 1958) as support for the position of obviousness. In relevant part, the Office Action states:

mutually adjacent suction piece sections in that they both impede the flow of air. Bryant does not disclose a motor for exerting a suction effect on the skin. The suction in the Bryant invention is created manually. However, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent- mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Assuming *arguendo* that *In re Venner* remains good law, and that the case is germane to the facts presently at hand, the Office Action has failed to provide evidence in support of the applied law. Notably, the Office Action provides no evidence of the motor that is being combined with *Bryant*. For at least this reasons, Applicants respectfully submit that the rejection of claim 1 is improper and should be withdrawn.

The above notwithstanding, Applicants further traverse the rejection as being based impermissively on hindsight. Notably, no art has been cited in support of the motor as featured in claim 1. Respectfully, Applicants submit that the present Office Action without basis in fact is relegating at least one feature of claim 1 to merely an obvious inclusion. There is no teaching or suggestion to include the motor in the applied art; and Applicants submit that the Examiner has cobbled a rejection using Applicants' claim as a template for its own reconstruction. A rejection so cobbled is improper.

For at least the reasons set forth above, Applicants respectfully submit that claim 1 is patentable over the applied art. Moreover, claims 2-7, which depend from claim 1 are patentable over the applied art for at least the same reasons.

ii. Claim 8

a. **The Office Action fails to comply with MPEP § 706**

Claim 8 is drawn to a suction piece for a personal care apparatus. The suction piece includes:

at least one circumferentially defined suction aperture for suction-based interaction with the human skin, wherein the suction piece in the area of the suction aperture is designed to form a skin protuberance in a suction-based interaction with the skin;

at least two suction piece sections extending to the suction aperture and defining the suction aperture, said two suction piece sections being radially adjustable and designed to exert a radial force on a skin protuberance formed in a suction-based interaction with the skin;

at least two sealing parts of elastically deformable design extending to the suction aperture and defining the suction aperture, each sealing part being situated between two mutually adjacent suction piece sections and having an airtight connection to the two mutually adjacent suction piece sections.

The germane portion of the Office Action, which is substantively identical to the non-final rejection, states:

As to claims 1 and 8, Bryant discloses a personal care apparatus with an air pump 10, a suction piece 18, an aperture (interior of 18, Figure 3), two suction piece sections 11 (flange 11 has upper and lower sections) designed to exert a radial force on a skin protuberance (lines 70-82); at least two sealing parts 20, 12 between two mutually adjacent suction piece sections and having an airtight connection to the mutually adjacent suction piece sections in that they both impede the flow of air.

As noted in the Response under Rule 111, a comparison between the features of the claims and the captioned portion of the claim reveals that certain features were not even addressed in the Office Action. For instance, the claim features that the two suction piece sections [are] radially adjustable. Therefore the Office Action fails to articulate a

rejection in a clear manner and thus deprives Applicants the opportunity at the earliest instance to provide evidence of patentability. Applicants cite MPEP § 706 and submit that the present rejection fails to comply with this section.

For at least the reasons set forth above, Applicants respectfully submit that a proper rejection of claim 8 has not been made. Therefore claim 8 is patentable. Moreover, claims 9-17, which depend from claim 8, are also patentable for at least the same reasons.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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